

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-5 and 7-137 are pending in this case. Claims 7-9, 12-24, 26, 28-31, 33-40, 70-104, 115-128, and 132-137 are withdrawn. Claim 6 has been canceled without prejudice or disclaimer. Claims 1, 25, 106, and 129-131 have been amended by the present Amendment. Amended Claims 1, 25, 106, and 129-131 are supported by original Claims 1, 6, 25, 106, 129-131, and page 55, lines 2-6 of the specification. No new matter has been added.

In the outstanding Office Action, Claims 25, 41-69, 106, 108, 129, and 131 were rejected under 35 U.S.C. §112, second paragraph, as indefinite; Claims 1-4, 10, 25, 32, 41-46, 48-51, and 53-54 were rejected under 35 U.S.C. §102(b) as anticipated by Dray, Jr. et al. (U.S. Patent Publication No. 2002/0184485, hereinafter "Dray"). Claims 129-130 were rejected under 35 U.S.C. §102(b) as anticipated by Miyazaki et al. (U.S. Patent Publication No. 2001/0044780; hereinafter "Miyazaki"); Claims 5, 47, and 52 were rejected under 35 U.S.C. §103(a) as unpatentable over Dray; Claims 11, 55-69 were rejected under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman (U.S. Patent No. 6,249,794); Claim 27 was rejected under 35 U.S.C. §103(a) as unpatentable over Dray in view of Wagner (U.S. Patent Publication No. 2004/0006562); Claim 131 was rejected under 35 U.S.C. §103(a) as unpatentable over Miyazaki; and Claims 105-112, and 114 were rejected under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson et al. (U.S. Patent No. 6,021,202; hereinafter "Anderson"); and Claim 113 was rejected under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson and further in view of Hidalgo et al. (U.S. Patent Publication No. 2003/0051142; hereinafter "Hidalgo").

In response to the rejection of Claim 25 under 35 U.S.C. §112, second paragraph, Applicants amend Claim 25 to correct the noted informality. Accordingly, Applicants respectfully request the rejection of Claim 25 be withdrawn.

In response to the rejection of Claims 41-69 under 35 U.S.C. §112, second paragraph, Applicants respectfully submit that the term “feature amount” is a term well known in the art. Further, Applicants point to page 64, lines 14-16 of the present application which describe that “a method of computing the feature amount is known in the electronic signature art.” Accordingly, Applicants respectfully request the rejection of Claims 41-69 under 35 U.S.C. §112, second paragraph, be withdrawn.

In response to the rejection of Claim 106 under 35 U.S.C. §112, second paragraph, Applicants have amended Claim 106 to correct the noted informality. Accordingly, Applicants respectfully request the rejection of Claim 106 under 35 U.S.C. §112, second paragraph, be withdrawn.

In response to the rejection of Claim 129 under 35 U.S.C. §112, second paragraph, Applicants have amended Claim 129 to clarify the claim language. Accordingly, Applicants respectfully request the rejection of claim 129 under 35 U.S.C. §112, second paragraph, be withdrawn.

In response to the rejection of Claim 131 under 35 U.S.C. §112, second paragraph, Applicants have amended Claim 131 to clarify the claim language. Accordingly, Applicants respectfully request the rejection of Claim 131 under 35 U.S.C. §112, second paragraph, be withdrawn.

In response to the rejection of Claims 1-4, 10, 24, 32, 41-46, 48-51, and 53-54 under 35 U.S.C. §102(b) as anticipated by Dray, Applicants respectfully submit that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied reference.

Amended independent Claim 1 is directed to an encapsulated document structure including, *inter alia*:

...an operating program file storing an operating program that materializes the document information, a limitation being given to the operating program by a security function when the operating program is interpreted and executed by a computer,

wherein the document information file and the operating program file are encapsulated as a single document, and

wherein said operating program is initiated by an external start program....

Dray describes methods for communicating documents which include self-encryption and self-verification capabilities.¹ Paragraph [0082] of Dray states that “a method is provided for creating, self-encrypting/decrypting electronic document objects (SEDOs) that contain an embedded Cipher Management Program (CMP). The encryption and decryption processes are encapsulated within the SEDOs.” However, Dray fails to teach or suggest that “said operating program is initiated by *an external start program*,” as in Applicants’ amended independent Claim 1.

In Dray, encryption and decryption is performed by an encryption management application program (CMP) that is contained in an electronic document (SEDO) to be encrypted, which encrypts/decrypts an electronic document using a key, so that encryption and decryption can be performed by the electronic document alone (i.e. without an external program). In contrast, in Applicants’ amended Claim 1, although the operating program is contained in the electronic document together with the information file, the operating program is limited by a security function and is initiated by an *external* start program.

Further, the program in Dray is not limited by a security function. In Applicants’ Claim 1, the operating program is limited by a security function (e.g. program code which

¹ See Dray at paragraph [0021].

cannot be executed unless it is decrypted). Thus, Dray describes an electronic document containing a program for decrypting encrypted information, while Applicants' electronic document contains the program for decrypting encrypted information which can be executed after the program is decrypted. In other words, the electronic document of Dray contains a program for controlling security while Applicants' electronic document contains a program of which security is controlled. Thus, the document of Dray can be decrypted without an encryption decrypting program because an encryption decrypting program is contained in the document itself. Because Applicants' electronic document has an operating program that is initiated by an external start program, and the operating program is limited by a security function, the operating program cannot be executed unless it is decrypted. An advantageous feature of the structure of Applicants' electronic document is that it prevents unauthorized programs, such as computer virus, from entering the electronic document.

Accordingly, Applicants respectfully submit that independent Claim 1 and all claims depending therefrom patentably define over Dray.

Accordingly, Applicants respectfully request the rejection of Claims 1-4, 10, 25, 32, 41-46, 48-51, and 53-54 under 35 U.S.C. §102(b) as anticipated by Dray, be withdrawn.

In response to the rejection of Claims 129-130 under 35 U.S.C. §102(b) as anticipated by Miyazaki, Applicants respectfully submit that amended independent Claim 129 recites novel features clearly not taught or rendered obvious by the applied reference.

Independent Claim 129 is directed to an encapsulated document structure including, *inter alia*:

...wherein said contents information, said operating program and said sending location information are encapsulated into a single document, and

wherein said operating program includes:

an operation processing program of which operation process on said contents information is limited based on authority information; and

a limitation cancellation program for canceling a limitation in the operation process of said operation processing program by sending various kinds of information based on said sending location information.

Figure 1 of Miyazaki shows a digital contents distribution center 1 for distributing digital contents. Information transmission medium 3 connects the digital contents distribution center 1 with user terminals 2 in order to convey information. Contents encapsulation means 4 generates execution verify logic and links it with the digital contents. Also, Figure 1 of Miyazaki shows execution verify logic conversion software generating means 5 for generating execution verify logic conversion software including execution verify logic conversion means for converting the execution verify logic of encapsulated contents into newly generated execution verify logic.²

However, Miyazaki fails to teach or suggest “wherein said operating program includes: an operation processing program of which operation process on said contents information is limited based on authority information; and ***a limitation cancellation program for canceling a limitation in the operation process*** of said operation processing program by sending various kinds of information based on said sending location information,” as in Applicants’ amended independent Claim 129.

In Miyazaki, the first execution verify logic 7 is replaced with second execution verify logic having looser access restrictions, if the user sends to the digital contents distribution center a request for purchasing the greater rights, and pays a charge for the request.³ After receiving the execution verify logic conversion software, the user applies the execution verify logic conversion software to the trial-use encapsulated contents and this enables the actual-use encapsulated contents to be installed. However, Miyazaki does not describe an

² See Miyazaki at paragraph [0047].

³ See Miyazaki at paragraph [0059].

encapsulated document structure including an operating program which further includes an operation processing program and limitation cancellation program for canceling a limitation in the operation process of the operation processing program by sending various kinds of information based on the sending location information.

In Miyazaki, the first execution verify logic 7 is replaced with the second execution verify logic by the digital contents distribution center 1 through the information transmission medium 3. The user terminal 2 applies the execution verify logic conversion software to encapsulated contents 6, thereby replacing the first execution verify logic 7 in the encapsulated content 6 with the second execution verify logic.⁴ In contrast, in Applicants' amended independent Claim 129, a limitation cancellation program is contained within an encapsulated document structure and the limitation cancellation program cancels a limitation in the operation process of the operation processing program by sending various kinds of information based on sending location information. Assuming *arguendo*, that the execution verify logic conversion software in Miyazaki is "a limitation cancellation program," the execution verify logic conversion software is contained in the digital contents distribution center 1, and not in an "encapsulated document structure." Thus, Applicants respectfully submit that independent Claim 129 and all claims depending therefrom patentably distinguish over Miyazaki.

Accordingly, Applicants respectfully request the rejection of Claims 129-130 under 35 U.S.C. §102(b) as anticipated by Miyazaki, be withdrawn.

In response to the rejection of Claims 5, 47, and 52 under 35 U.S.C. §103(a) as unpatentable over Dray, Applicants note that Claims 5, 47, and 52 are dependent on independent Claim 1 and thus are believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection be withdrawn.

⁴ See Miyazaki at paragraph [0056] to [0057].

In response to the rejection of Claim 11 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman, Applicants note that Claim 11 is dependent on Claim 1 and is thus believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection be withdrawn.

In response to the rejection of Claims 55-64 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman, Applicants respectfully request reconsideration of the rejection and traverse the rejection as discussed next.

Independent Claim 55 is directed to an encapsulated document structure including, *inter alia*:

...a feature amount retaining file retaining an encrypted feature amount regarding said operating program file,

wherein said document information file, said location information and said feature amount retaining file are encapsulated into a single file.

Dray fails to teach or suggest “a feature amount retaining file retaining an encrypted feature amount regarding said operating program file,” as recited in Applicants’ independent Claim 55. Page 18 of the outstanding Office Action contends that paragraph [0061] of Dray teaches Applicants’ “feature amount retaining file.” Page 18 also states that the Examiner interprets the phrase “feature amount retaining file” as the electronic signature of the document structure. However, the feature amount retaining file in Applicants’ Claim 55 retains an encrypted feature amount regarding the *operation file*, not a feature amount regarding the document structure.

Paragraph [0061] of Dray describes that “[t]he embedded signature program decomposes a data structure representing a P-SSDO [processed self-signing signature document object] into a linear sequence of bits, as required by electronic signature algorithms, and retrieves the user’s private signature key. The bit sequence and the signature key are then passed to an appropriate signature algorithm...which generates and returns an

electronic signature.” “The resulting electronic signature represents the state of the P-SSDO and the identity of the user responsible for creating the P-SSDO.” However, the signature key in Dray is not “a feature amount regarding said *operation program file*,” (the operation file being a component of the encapsulated document structure) but rather a private signature key of a self-signing signature document object (the entire structure).

Paragraph [0061] of Dray also states that a signature algorithm may be an integral part of a signature processing program embedded in the self-signing signature document. However, a signature algorithm is not “a feature amount retaining file retaining an encrypted feature amount regarding said operating program file.” In Dray, the signature algorithm merely generates an electronic signature, it is not an operating program file storing an operating program for materializing the document information file.

Accordingly, Applicants respectfully request the rejection of Claims 55-64 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman, be withdrawn.

In response to the rejection of Claims 65-69 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman, Applicants respectfully request reconsideration of the rejection and traverse the rejection as discussed next.

Independent Claim 65 is directed to an encapsulated document structure including,
inter alia:

...the document information file and the location information are encapsulated into a single file, and a feature amount regarding the operating program file is stored outside said single file.

Applicants respectfully traverse the obviousness rejection based on Dray and Raman.⁵

Neither Dray nor Raman teach or suggest that “the document information file and the

⁵ See MPEP 2143.01 stating “[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” (citations omitted). See also MPEP 2144.08 III stating that “[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.

location information are encapsulated into a single file, and a feature amount regarding the operating program file is stored outside said single file,” as in Applicants’ independent Claim 65.

Page 24 of the outstanding Office Action recognizes that the “cited portions of the combined references do not explicitly teach a feature amount regarding the operating program file is stored outside said single file.” The outstanding Office Action states that the proposed modification “would have been obvious to one of ordinary skill in the art at the time of the invention to include an operating program outside of the document.”⁶ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.⁷ Here, while the Office Action states that it would have been obvious to include an operating program outside of the document, the reason appears to be based on impermissible hindsight reconstruction.

The U.S. Court of Appeals for the Federal Circuit recently vacated a rejection under 35 U.S.C. § 103(a) based on similar grounds.⁸ In vacating a rejection, the Court stated:

The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another without providing a citation of any relevant, identifiable source of information justifying such substitution. ***The statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans.*** At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.” *Lee*, 277 F.3d at 1344. Under such circumstances, with respect to core factual findings, “the Board must point to some concrete evidence in the record in support” of them, rather than relying on its assessment of what is “well recognized” or what a skilled artisan would be “well aware.” (emphasis added)

... Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings.”

⁶ See outstanding Office Action at page 24.

⁷ *In re Lee*, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) (“The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion”).

⁸ *In re Beasley*, 2004 U.S. App. LEXIS 25055 (Fed. Cir. December 2004)

Accordingly, Applicants respectfully request the rejection of 65-69 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Raman, be withdrawn.

In response to the rejection of Claim 27 under 35 U.S.C. §103(a) as unpatentable over Dray in view of Wagner, Applicants note that Claim 27 is dependent upon independent Claim 1 and thus is believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection of Claim 27 be withdrawn.

In response to the rejection of Claim 131 under 35 U.S.C. §103(a) as unpatentable over Miyazaki, Applicants note that Claim 131 depends from independent Claim 129 and thus is believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection of Claim 131 under 35 U.S.C. §103(a), be withdrawn.

In response to the rejection of Claims 105-112, and 114 under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson, Applicants respectfully request reconsideration of the rejection and traverse the rejection as discussed next.

Independent Claim 105 is directed to an electronic document file including, *inter alia*:

...a plurality of operating programs and operating
program use information provided by an operating program
provider....

Page 29 of the outstanding Office Action cites paragraph [0049] of Miyazaki for describing “***a plurality of operating programs*** and operating program use information provided by an operating program provider; and a contents file and contents use information produced by said operating program provider or a document producer.” However, paragraph [0049] merely describes that “the digital contents 8 include, for example, images, motion pictures, voice, text, software or their combinations. The first execution verify logic 7 consists of codes for controlling reference and execution operations in the course of

displaying initial messages at a start, verifying the current digital contents 8, and making decisions of a user ID, machine ID or date and time, and is described using programming interface prepared for manipulating the digital contents 8.”

In Miyazaki, there is not *a plurality* of operating programs contained *in the electronic document file* but rather first execution verify logic 7 included in the encapsulated contents 6, as shown in Figure 2 of Miyazaki. Assuming *arguendo*, that the first execution verify logic 7 in Miyazaki is equivalent to Applicants’ “operating programs,” Miyazaki does not describe that the encapsulated contents 6 include a plurality of first execution verify logic 7. Also, when a user is given broader rights, the first execution verify logic 7 is replaced with second execution verify logic.⁹ Thus, in this case, only one execution verify logic is included in the encapsulated contents 6 and there is not “a plurality of operating programs” in the electronic document file as in Applicants’ independent Claim 105.

Further, Applicants respectfully submit that Anderson fails to cure any of the above-noted deficiencies of Miyazaki.

Accordingly, Applicants respectfully submit that independent Claim 105 patentably defines over the cited references.

Claims 106-112, and 114 are dependent on independent Claim 105 and thus are believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection of Claims 105-112 and 114 under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson, be withdrawn.

In response to the rejection of Claim 113 under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson and further in view of Hidalgo, Applicants note that Claim 113 is dependent on independent Claim 106 and is thus believed to be patentable for at least the reasons discussed above. Accordingly, Applicants respectfully request the rejection

⁹ See Miyazaki at paragraph [0057].

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of Claim 113 under 35 U.S.C. §103(a) as unpatentable over Miyazaki in view of Anderson
and further in view of Hidalgo, be withdrawn.

Consequently, in view of the present amendment, and in light of the above discussion,
the pending claims as presented herewith are believed to be in condition for formal
allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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